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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,926	02/07/2005	Jan van Walraven	WALRAVEN3	1885
1444 7590 10/18/2007 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			EXAMINER DUMAS, NKEISHA J	
			ART UNIT 3632	PAPER NUMBER
			MAIL DATE 10/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/523,926	Applicant(s) VAN WALRAVEN, JAN	
	Examiner Nkeisha J. Dumas	Art Unit 3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/25/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/27/2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following correspondence is an Office Action for application number 10/523,926, for a VIBRATION ISOLATING PIPE CLIP, filed on 2/7/2005. This correspondence is in response to applicant's request for continued examination filed on 9/25/2007. Claim 53 is pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Walraven (EP 1,106,900 A1).

Regarding claim 53, Van Walraven teaches a vibration isolating pipe clip (1) comprising a rigid pipe clip body (2, 3) which is composed of one or more parts and is provided with securing means (7); a vibration isolating member (10) which bears against an inner circumference of the pipe clip body and is ultimately positioned between an outer circumference of the pipe and the pipe clip body (Fig. 1), wherein the vibration isolating member (13) is a porous vulcanized rubber with closed cavities and separating walls between them [0008, 0025], wherein the cavities are substantially unpressurized by dehydration of salt which remains in the cavities, in such a manner that in the event of a reduction in the volume of the cavities under the influence of deformation of the vibration isolating member, no significant pressure occurs inside the cavities [0025,

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0032], wherein the vibration isolating member has a form factor defined by the quotient of the surface area which is subject to load and the free surface area, and in which the cavities significantly reduce the form factor, but does not teach that the form factor of the isolating member is less than 0.2. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to make the vibration isolating member of the pipe clip with a form factor of less than 0.2 since the discovery of an optimum value of a result effective variable involves only routine skill in the art. The Examiner notes that the term "vulcanized" recited in the claim relates to a method of making the rubber. Where a method step is recited in an article claim, only the article recited by the method is considered. Therefore, it is unnecessary to find the method of vulcanization in order to determine the final rubber product, and therefore, only the rubber product made from the method is considered. In addition the phrase "by dehydration of salt which remains in the cavities" relates to a method of making the rubber. Again, where a method step is recited in an article claim, only the article recited by the method is considered. Therefore, it is unnecessary to find the method in order to determine the final rubber product, and therefore, only the rubber product made from the method is considered.

Response to Arguments

3. Applicant's arguments filed 8/27/2007 have been fully considered but they are not persuasive.

4. Applicant argues that the Van Walraven '900 reference is structurally different from the present invention disclosed in the application because Van Walraven does not teach cavities that are substantially unpressurized.

First, the Examiner notes that the limitation regarding the substantial unpressurization of the cavities relates to the method of making the rubber material. The applicant concedes this fact by stating on page 6, "[t]he fact that the closed cavities are unpressurized is the result of the rubber being made by using a hydrated salt in the rubber, wherein during vulcanization of the rubber water is cleaved off from the salt...." Thus, the unpressurization of the cavities is the result of the method of making the rubber. Because claim 53 is an article claim, and not a claim directed to the method of manufacturing the article, only the finished product is considered. Therefore, it is unnecessary to find the steps involved in the method of manufacturing the product.

Second, the Van Walraven reference teaches a porous closed cell rubber material that is inherently "substantially unpressurized". As taught by Van Walraven, when the material is compressed, the volume of the material is reduced. [00008] This indicates that the material inherently is substantially unpressurized because it is able to deform when compressed. If the converse was true, and the material was in fact pressurized, then it would not be able to deform. But that is not the case.

Finally, the statement regarding the substantial unpressurization of the cavities "in such a manner that in the event of a reduction in the volume of the cavities" is a functional limitation that relates to the use of the material and its behavior when subject to compression. A recitation of the intended use of the claimed invention must result in

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a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As indicated above, Van Walraven teaches a material that is capable of behaving "in such a manner that in the event of a reduction in the volume of the cavities under the influence of deformation of the vibration isolating member, no significant pressure occurs inside the cavities" simply by virtue of the elastic nature of the material.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nkeisha J. Dumas whose telephone number is (571) 272-5781. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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